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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,246	09/17/2003	Todd A. Stiers	IDET1270-1	3741

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EXAMINER	
FRANKLIN, RICHARD B	
ART UNIT	**PAPER NUMBER**
2181	

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/664,246	STIERS ET AL.	
	Examiner	Art Unit	
	Richard Franklin	2181	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 December 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *65-104* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *65-104* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

FRITZ FLEMING
Supervisory PRIMARY EXAMINER
GROUP 2100
Art Unit 2181
3/13/2006

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 65 – 104 have been examined.

Response to Arguments

2. Applicant's arguments with respect to claims 65 – 104 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 65 – 104 are rejected under 35 U.S.C. 101 because the claims fail the practical application test. The claims recite data transformation per se with no tangible result.

As per claims 65 – 78 and 94 – 103, the claims recite non-statutory subject matter that is directed solely to data transformation with no claimed tangible result. There is an intermediary claim that is tangible ("storing each of the sets of portions"), but the claim, when taken as a whole, does not produce a tangible result. The result of the claims appear to be a thought (selection) or a mere computation within a processor rather than a real world tangible result that is a practical application of the abstract idea of "selecting." "Selecting" data "for delivery to the device" recites an intended use and does not produce a tangible result since the data is not actually delivered to the device.

As per claims 79 – 93, the claims recite non-statutory subject matter that is directed solely to data transformation with no claimed tangible result. The result of the claims appear to be a thought (selection) or a mere computation within a processor rather than a real world tangible result that is a practical application of the abstract idea of "selecting." "Selecting" data "for delivery to the device" recites an intended use and does not produce a tangible result since the data is not actually delivered to the device.

As per claims 94 – 103, , the claims recite non-statutory subject matter that is directed solely to data transformation with no claimed tangible result. There is an intermediary claim that is tangible ("storing each of the sets of portions"), but the claim, when taken as a whole, does not produce a tangible result. The result of the claims appear to be a thought (selection) or a mere computation within a processor rather than a real world tangible result that is a practical application of the abstract idea of "selecting." "Selecting" data "for delivery to the device" recites an intended use and does not produce a tangible result since the data is not actually delivered to the device.

As per claim 104, the claim recites non-statutory subject matter that is directed solely to data transformation with no claimed tangible result. The result of the claim appears to be a thought (selection) or a mere computation within a processor rather than a real world tangible result that is a practical application of the abstract idea of "selecting." "Selecting" data "for delivery to the device" recites an intended use and does not produce a tangible result since the data is not actually delivered to the device.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 65 and 79 are rejected under 35 U.S.C. 102(e) as being anticipated by Son et al. US Patent Application Publication No. 2002/0026645 (hereinafter Son).

As per claim 65, Son teaches a method for packaging and distributing data to a device comprising: separating the data into an original set of portions (Son; Paragraph [0036]); converting each of the original set of portions into multiple formats to produce sets of portions, each set of portions in a distinct format (Son; Paragraphs [0033] and [0036]); storing each of the sets of portions (Son; Paragraph [0036]); evaluating a set of criteria (Son; Paragraphs [0032] and [0039] – [0040]); and selecting at least a first portion of one of the sets of portions in a first format for delivery to the device based on the evaluation of the set of criteria (Son; Paragraphs [0032] and [0039] – [0040]).

As per claim 79, Son teaches a method for packaging and distributing data to devices on a communication network, comprising: separating the data into an original set of portions (Son; Paragraph [0036]); converting a first portion of the original set of

portions into a first format and a second format, wherein the first format is distinct from the second format (Son; Paragraphs [0033] and [0036]); evaluating a first set of criteria associated with a first device on the communication network (Son; Paragraphs [0032] and [0039] – [0040]); evaluating a second set of criteria associated with a second device on the communication network (Son; Paragraph [0043]); selecting the first portion in the first format for delivery to the first device on the communication network based on the evaluation of the first set of criteria (Son; Paragraphs [0032] and [0039] – [0040]); and selecting the first portion in the second format for delivery to the second device on the communication network based on the evaluation of the second set of criteria (Son; Paragraph [0043]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 66 – 78, and 80 – 104 are rejected under 35 U.S.C. 103(a) as being unpatentable over Son et al. US Patent Application Publication No. 2002/0026645 (hereinafter Son) in view of Tso et al. US Patent No. 6,421,733 (hereinafter Tso).

As per claim 66, Son teaches the method as described per claim 65 above.

Son does not teach evaluating an updated set of criteria, and selecting a stored second format for delivery to the device based on the evaluation of the updated set of criteria.

However, Tso teaches a data distribution system that evaluates an updated set of criteria (Tso; Col 11 Lines 29 – 32), and selects a stored second format for delivery to the device based on the evaluation of the updated set of criteria (Tso; Col 11 Lines 37 – 40).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the teachings of Son to include the updated criteria because it allows the user to provide a means for communicating preferences to the server (Tso; Col 11 Lines 19 – 24).

As per claim 67, Son also teaches wherein the second format is distinct from the first format (Son; Paragraph [0036]).

As per claim 68, Tso also teaches delivering the first portion and second portion to the device (Tso; Col 11 Lines 37 – 40).

As per claims 69 and 81, Tso also teaches evaluating the set of criteria is done using a set of rules, each of the set of rules pertaining to one or more of the set of criteria (Tso; Col 7 Line 15 – Col 8 Line 8).

As per claims 70 and 82, Tso also teaches wherein each of the set criteria is pertinent to at least one of the set of rules (Tso; Col 7 Line 15 – Col 8 Line 9).

As per claims 71 and 83, Tso also teaches determining one or more of the set of criteria (Tso; Col 7 Line 15 – Col 8 Line 9).

As per claims 72, 84, and 103, Tso also teaches determining one or more of the set of criteria comprises querying the device (Tso; Col 7 Lines 21 – 29).

As per claims 73 and 85, Tso also teaches wherein the set of criteria include a set of user influenced factors and a set of external factors (Tso; Col 7 Lines 21 – 29 and 43 – 54).

As per claims 74 and 86, Tso also teaches wherein the set of user influenced factors include a type of the device, a bandwidth associated with the device or setting of the device (Tso; Col 7 Lines 21 – 29).

As per claims 75, 87 and 95, Tso also teaches augmenting at least one of the original set of portions (Tso; Col 8 Lines 10 – 21, Col 8 Line 62 – Col 9 Line 2).

As per claims 76, 88, and 96, Tso also teaches wherein augmenting at least one of the original set of portions comprises close captioning or adding commercials (Tso; Col 8 Lines 10 – 21, Col 9 Lines 29 – 41).

As per claims 77, 89, 91, and 97, Tso also teaches augmenting the first portion selected for delivery of the device (Tso; Col 8 Lines 10 – 21, Col 8 Line 62 – Col 9 Line 2).

As per claims 78, 90, 92, and 98, Tso also teaches wherein the first portion is augmented based on the set of criteria (Tso; Col 8 Lines 10 – 21 Col 9 Lines 26 – 29).

As per claim 80, Son teaches the method as described per claim 79 above.

Son does not teach evaluating an updated first set of criteria associated with the first device on the communication network; and selecting a second portion in a third format for delivery to the first device on the communication network based on the evaluation of the updated first set of criteria, wherein the third format is distinct from the first format.

However, Tso teaches evaluating an updated set of criteria (Tso; Col 11 Lines 29 – 32), and selecting a second portion in another format based on the evaluation of the updated criteria (Tso; Col 11 Lines 37 – 40).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the teachings of Son to include the

updated criteria because it allows the user to provide a means for communicating preferences to the server (Tso; Col 11 Lines 19 – 24).

As per claim 93, Tso teaches wherein the first portion in the first format is augmented differently from the first portion in the second format (Tso; Col 8 Lines 10 – 21, Col 9 Lines 26 – 41).

As per claim 94, Son teaches A method for packaging and distributing data to a device, comprising: separating the data into an original set of portions; converting each of the original set of portions into multiple formats to produce sets of portions, each set of portions in a distinct format; storing each of the set of portions; evaluating a set of criteria; and selecting a stored first portion in a first format for delivery to the device based on the evaluation of the set of criteria.

Son does not teach augmenting the data by adding additional data.

However, Tso teaches augmenting the data by adding additional data (Tso; Col 8 Line 62 – Col 9 Line 2).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the teachings of Son to include augmenting the data because that allows items to be added dynamically to the content before it is displayed to the user (Tso; Col 8 Line 67 – Col 9 Line 2).

As per claim 99, Tso also teaches evaluating an updated set of criteria (Tso; Col 11 Lines 29 – 32); and selecting a stored second portion in a second format for delivery to the device based on the evaluation of the updated set of criteria (Tso; Col 11 Lines 37 – 40).

As per claim 100, Tso also teaches augmenting the second portion selected for delivery to the device (Tso; Col 8 Lines 10 – 21, Col 8 Line 62 – Col 9 Line 2).

As per claim 101, Tso also teaches wherein the second portion is augmented based on the updated set of criteria (Tso; Col 8 Lines 10 – 21 Col 9 Lines 26 – 29).

As per claim 102, Tso also teaches updating the set of criteria (Tso; Col 11 Lines 29 – 42).

As per claim 104, Son teaches a method for packaging and distributing data to devices on a communication network, comprising: separating the data into an original set of portions (Son; Paragraph [0036]); converting the original set of portions into a first format and a second format, wherein the first format is distinct from the second format (Son; Paragraphs [0033] and [0036]); evaluating a set of criteria (Son; Paragraphs [0032] and [0039] – [0040]); and selecting a first portion in the first format for delivery to a device on the communication network based on the evaluation of the set of criteria (Son; Paragraphs [0032] and [0039] – [0040]).

Son does not teach evaluating an updated set of criteria, and selecting a second format for delivery to the device based on the evaluation of the updated set of criteria.

However, Tso teaches a data distribution system that evaluates an updated set of criteria (Tso; Col 11 Lines 29 – 32), and selects a second format for delivery to the device based on the evaluation of the updated set of criteria (Tso; Col 11 Lines 37 – 40).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the teachings of Son to include the updated criteria because it allows the user to provide a means for communicating preferences to the server (Tso; Col 11 Lines 19 – 24).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Franklin whose telephone number is (571) 272-0669. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fritz Fleming can be reached on (571) 272-4145. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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